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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,852	07/03/2002	Jurgen Marki	GKS-101.0(7911/83687)	1442
24628	7590	03/21/2005	EXAMINER	
WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606			MAYER, SUZANNE MARIE	
			ART UNIT	PAPER NUMBER
			1653	

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,852

Applicant(s)

MARKI ET AL.

Examiner

Suzanne M. Mayer, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-31 and 34-38 is/are pending in the application.
- 4a) Of the above claim(s) 20,22-26,28-31 and 34-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 10/049,988.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with partial traverse of Group VII, claims 20-31 and 34-38 drawn to SEQ ID No: 73 in the reply filed on 17 February 2005 is acknowledged. The traversal is on the grounds that domains b through h should not be severable and restricted from the entire protein, and should be joined with SEQ ID No: 73 which is drawn to KLH1 hemocyanin domain h from *Megathura crenulata*. It is further submitted that the sequences from the different organism, *Haliotis tuberculata* should also be joined and searched together with those from *M. crenulata* because the proteins are orthologs that share high homology and thus a search of one would overlap with another. This is not found persuasive because each domain from both proteins possesses different immunological functions and thus are patentably distinct from one another because each can be used in a different capacity from one another or even the entire protein as a whole. Furthermore, Applicants argument that KLH1 hemocyanin domains f-h, and as an example of this SEQ ID Nos: 71-73, represents the entire protein in smaller pieces and thus should be examined together, however, clearly this is not the case since SEQ ID Nos: 42, 43, 46 and 48 are only partial domains. Thus these sequences do not make up the entire KLH2 protein. Furthermore, the search for each protein sequence claimed would a separate search by the Examiner which would constitute an undue search burden because of the amount of time needed to review the large amount of data expected to be obtained by the search.

The requirement is still deemed proper and is therefore made FINAL.

### ***Status of the Claims***

2. Group VII and thus Claims 20-31 and 34-38, drawn to SEQ ID No: 73 which is domain h from *Megathura crenulata* KLH1 hemocyanin, are pending in this application. However, claims 20, 22-26, 28-31 and 34-38 are drawn to non-elected subject matter and are therefore withdrawn from further consideration. Additionally, non-elected claims 1-19, 32-33 and 39-44 are also withdrawn from consideration. Claims 21 and 27 are thus pending.

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. Priority document 19911971.6 03/17/1999 can be located in related US application 1/049,988.

### ***Information Disclosure Statement***

4. The information disclosure statements (IDS) submitted on 26 November 2002 and 18 July 2003 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner. Foreign Patent EP-0 252 829 A1 has not been considered by the Examiner as no English translation of the document or abstract was provided. See signed and attached PTOL-1449.

### ***Specification***

5. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.
6. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Specifically what is missing in the specification of the instant application is a-c and e-j. It should be noted that in (b), the cross-reference statement should be the first line in the specification.

Appropriate correction is required.

### ***Drawings***

7. The drawings are objected to because if Applicant wishes that any drawings to be considered in this application, separate drawings must be submitted that are separate from the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 21 and 27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Polypeptide sequences encoding a structural protein exists in nature. The claimed invention does not show the “hand of man.” Amending the claim to require that the polypeptide is isolated would be remedial.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 21 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The claims are drawn to polypeptides of SEQ ID No: 73 and fragments thereof. The claims mererly recite that the fragments must possess the same immunological activity as the full length polypeptide. There is no recitation as to what part of the full length polypeptide is essential for this activity and which is therefore conserved. Thus,

the claims are drawn to an undefined genus of amino acids with the only potential to recognize them being by sequence identity.

To provide evidence of possession of a claimed genus, the specification must provide sufficient distinguishing identifying characteristics of the genus. The factors to be considered include disclosure of complete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed product, or any combination thereof. In this case, the only factors present in the claims are the partial structure thereof. Accordingly, in the absence of sufficient recitation of distinguishing identifying characteristics, the specification does not provide adequate written description.

*Vas-Cath Inc. V. Mahurkar*, 19USPQ2d 1111, clearly states that “applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention*. The invention is, for purposes of the ‘written description’ inquiry, *whatever is now claimed*.” The specification does not “clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” As discussed above, the skilled artisan cannot envision the detailed structures of fragments thereof pertaining to either or both the polypeptide of SEQ ID No: 73, and therefor conception is not achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the methods of making the claimed invention. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of isolating or making it. The



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compound itself is required. See *Fiers v. Revel*, 25 USPQ2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016.

### ***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.


13. Claims 21 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Söhngen et al. (1997 - Cited on the IDS submitted on 18 July 2003). Söhngen et al. teach the isolation and separation of individual subunits from KLH1 and their molecular masses as assessed by SDS-PAGE. Specifically, Figure 6 (p. 607) shows the isolation of the h subunit of KLH1 derived from *M. crenulata*. The claims are anticipated because, by all comparable data, the invention now claimed and the protein of the prior art are the same or equivalent protein because the genus and species of bacteria are identical, the relative molecular weight of the protein isolated in the gel is identical. In addition, the protein has the same or equivalent amino acid sequence whether the amino acid sequence is known or not, as the amino acid sequence is an inherent characteristic of a protein or polypeptide.


**Conclusion**

14. No claim is allowed.
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzanne M. Mayer, Ph.D. whose telephone number is 571-272-2924. The examiner can normally be reached on Monday to Friday, 8.30am to 5.00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
SMM  
11 March 2005

  
ROBERT A. WAX  
PRIMARY EXAMINER  
*Art Unit 1653*